

REMARKS

INTRODUCTION

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested.

Claims 1-7 are pending and under consideration.

REJECTIONS UNDER 35 USC 103

Claims 1-7 stand rejected under 35 USC §103(a) as being obvious over Satoh et al., U.S. Patent No. 5,038,659, in view of Tanimoto, U.S. Patent No. 4,450,743. This rejection is respectfully traversed.

The Examiner has essentially reissued his previous rejections, while making the present Office Action Final. In applicant's last response, applicant pointed out to the Examiner the legal inadequacies of the pending rejection.

However, the Examiner again would appear to have disregarded applicant's remarks and merely reissued his previous rejections, without addressing applicant's contention that the present rejection fails to present a prima facie obviousness case.

As pointed out before, the Examiner set forth several unsupported reasons why it would have been obvious to modify Satoh et al. to include features of Tanimoto, to disclose the present claimed invention, including the fact that although Satoh et al. fails to disclose a "correspondence or result of the input data in relation to notes" in a table form, it would have been obvious to show the same relationship.

In addition, in response to applicant's previous response pointing out the legal inadequacies of the underlying rejections, the Examiner merely repeated the contention that because a primary reference (Satoh et al.) is being interpreted as disclosing features A and a secondary reference (Tanimoto) discloses features B (for a particular reason related to the invention of the secondary reference), it would have been obvious to combine features A and B, apparently merely because the two references are in purported related fields.

The Office Action further sets forth several conclusory statements based primarily on the Examiner's beliefs, without any evidence in the record.

For example, the Examiner states that "[w]hile Satoh et al. shows the correspondence or result of the input date in relation to the notes, it is obvious that the same could be shown in a

table to show the same relationship." This is a conclusory statement that is not supported by the record. To show obviousness, very particular elements are required, including motivation for such obviousness. The fact that Satoh et al. could be modified, and that such a modification is obvious in the eyes of the Examiner, is irrelevant. There must be evidence in the record supporting the rationale that one skilled in the art would have found such a modification obvious based on some evidence leading that person to make the modification. There must be some reason to the modification, some benefit or need in Satoh et al. Here, Satoh et al. would appear to work satisfactorily and the modification of the same would appear only based on a forced attempt to read on the present claims.

In addition, the Examiner also sets forth that "Tanimoto provides that teaching which can be inherently seen in Satoh et al." However, if Satoh et al. inherently teaches such features, there is no need for use of Tanimoto. In addition, "when an examiner relies on inherency, it is incumbent on the examiner to point to the 'page and line' of the prior art which justifies an inherency theory." Ex parte Schricker, 56 USPQ2d 1723 (BdPatApp&Int 2000). Here, the Examiner appears to be making modifications of Satoh et al. with broad interpretations of the features of Satoh et al. and Tanimoto, mixing the features together, and concluding that the same could be combined to disclose the presently claimed invention.

Before again addressing the requirements of a prima facie obviousness case, the following is noted: "[i]t is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, "an agency is not free to refuse to follow circuit precedent." In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002).

Thus, the following precedent is binding in the present case and can not be ignored.

As recently pointed out by the Federal Circuit, "[r]ejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)(vacating a decision by The Board of Patent Appeals and Interferences ("Board") of the USPTO, which upheld an examiner's rejection where the motivation for a specific combination was not supported by the record; the vacated holding of Board was based on the premise that

"[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.")

As noted above, the Examiner would appear to essentially rely on the Examiner's own knowledge that one skilled in the art would have been led to modify Satoh et al., as suggested. For example, the Office Action states appear to indicate the motivation for modifying Satoh et al. would be "because Tanimoto provides a clear correlation of input data with stored data including note codes to produce output data." Thereafter, the Examiner merely determines that the modification of Satoh et al. would have therefore been obvious.

However, as noted above, an obviousness determination cannot be based on what the Examiner believes or what the Examiner believes one of common knowledge in the art would have derived from the references. To make such assertions would be improper as merely conclusory.

Conversely, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Presently, the outstanding rejection would appear to be inferring from Tanimoto how Satoh et al. could be modified, and thereby determining that such a modification would have been obvious. Thus, the Office Action fails to provide any motivation that would lead one skilled in the art to modify Satoh et al. The Examiner is required to provide the rationale behind the modification of Satoh et al. The fact that Tanimoto could be used to make that modification is irrelevant without a teaching in Tanimoto that Satoh et al. would need or desire such a modification.

However, as recited in MPEP § 2143.01, a proposed modification cannot change the principle of operation of a reference. This proposed modification of Satoh et al. would appear to change the operation of Satoh et al. As further set forth in MPEP § 2143.01, although the reference can be combined or modified, such is not sufficient to establish a prima facie obvious case.

It is lastly noted that MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper."

Again, the Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34.

The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Although the Examiner presently believes that the two references are combinable to disclose the presently claimed invention, it is respectfully submitted that the required supporting objective evidence supporting the reasoning behind such a combination has not been presented.

Therefore, for at least the above, it is respectfully submitted that the outstanding Office Action has failed to provide a prima facie obviousness case. It is respectfully requested that the outstanding rejections be withdrawn and claims 1-7 be allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

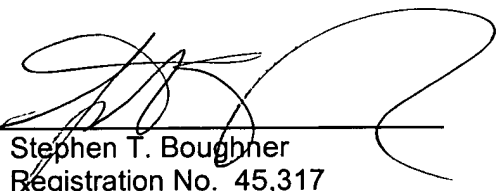
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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